REMARKS

Claims 1-18 are all the claims pending in the application.

Applicant amends claims 3, 9, 11 and 13-18 for precision of language and to ensure proper antecedent basis. No estoppel is created.

The Examiner cites new references and rejects all of the pending claims based on these references [1] as follows:

- claim 1, 3 and 13-18 under 35 U.S.C. § 103(a) as being unpatentable over Watts in view of Uehara et al. (Uehara);

- claims 5, 7, 9, 11 and 15-18 under 35 U.S.C. § 103(a) as being unpatentable over Ben-Meir et al. (Ben-Meir);

- claims 2 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Watts in view of Uehara and further in view of Montgomery (previously-cited); and

- claims 6, 8, 10 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Ben-Meir in view of Montgomery.

Applicant respectfully traverses these rejections as follows.

As explained in Applicant's previous Amendment filed September 24, 2003, Applicant's invention provides data processing devices (claims 1-12) and methods of operating data processing devices (claims 13-18) which comprise unique combinations of features and method steps, including, *inter alia*:

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[1] Applicant notes that in the Office Action, the Examiner presents a summary of each rejection (see paragraphs 4, 7, 10 and 12) followed by the respective analysis (see paragraphs 5-6, 8-9, 11 and 13), and that the listing of the claims in some of the summaries is inconsistent with the listing of the claims in the respective analysis that follows. Applicant assumes that the claims stand rejected as set forth in the respective analysis, with the exception of the dependent claims 2 and 4 being rejected based on the combination of Ben -Meir and Montgomery (see Office Action, paragraph 13), and responds accordingly.

a light-emitting unit which illuminates a display unit, a detector which detects whether a

specific functional part in the data processing device is in operation or not, and a controller

which limits a current to be supplied to the light-emitting unit when the detector has detected

that the specific functional part in the data processing unit is in operation (claim 1; see also

claims 5, 7, 13, 15 and 16); and

a plurality of light-emitting units which illuminate a display unit, a detector which detects

whether a specific functional part in the data processing device is in operation or not, and a

controller which controls a number of the light-emitting units to be turned on, when the

detector has detected that the specific functional part in the data processing unit is in operation

(claim 3; see also claims 9, 11, 14, 17 and 18).

None of the cited prior art references, applied alone or in any reasonable combinations,

discloses or suggests such unique combinations of features and method steps.

Rejections based on Watts, Uehara and Montgomery (claims 1-4 and 13-18)

Watts discloses a computer docking station "having connections made for coupling to

external monitor, an external keyboard, and means for connecting the portable computer to the

docking station" (see Id., Abstract). In particular, Watts provides:

> docking station having connection means for coupling to an external
> monitor, an external keyboard, and means for connecting the portable
> computer to the docking station. The docking station further includes
> means for determining whether or not the external monitor is coupled to
> the docking station, automatically displaying on the external monitor when
> the external monitor is coupled to the docking station and displaying on

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the display of the portable computer when said external monitor is not coupled to said docking station. (See Id., col. 2, lines 10-20)

The Examiner alleges that Watts' portable computer, which has an LCD display, "detects that it is connected to specific functional part, that is, an external monitor, [and] disables the LCD display" (see Office Action, pages 2-3). Applicant respectfully disagrees.

In fact, Watts discloses that "[p]ortable computer 13 is powered down and loaded into docking station 10, as illustrated in FIG. 3." (see Id., col. 4, lines 16-18). Clearly, in the powered down mode, Watts' portable computer is not capable of detecting whether <u>any</u> of its functional parts, let alone a specific functional part, is in operation or not. Furthermore, in its claim 1 (cited by the Examiner) Watts recites that it is the computer docking station, <u>not</u> the portable computer (as alleged by the Examiner), which comprises "means for determining whether or not said external monitor is coupled to said docking stations ... and disabling the monitor of the portable computer when said external monitor is coupled to said docking station" (see Id., col. 661, lines 2-12).

Thus, contrary to the Examiner's analysis Watts does <u>not</u> disclose, teach or suggest that portable computer 13 "detects" whether it is connected to an external device, and does <u>not</u> disclose, teach or suggest that portable computer 13 "disables" its LCD accordingly. Instead, Watts discloses a docking station which includes means for determining if an external monitor is connected thereto and disabling the LCD display of portable computer accordingly (see Id., col. 7, lines 56-60). Applicant respectfully submits that a docking station detecting whether an external

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monitor is connected thereto, as disclosed in Watts, has nothing to do with data processing device

detecting whether a specific functional part thereof is in operation or not, and controlling light-

emitting unit which illuminates a display based on such determination, as recited in Applicant's

independent claims 1, 3 and 13-18.

The Examiner acknowledges that Watts does not disclose a data processing device, or a

method for operating a data processing device, capable of detecting whether a specific functional

part in the data processing device is in operation or not (see Office Action, page 3), and relies on

Uehara to supply this acknowledged deficiency.

Uehara disclose a display control system for a "computer system including an LCD ... or

a plasma display as a standard display unit and allowing connection of a CRT display as an

optional display unit" (see Id., col. 1, lines 14-17). In particular, Uehara discloses a computer

system which includes display controller 24 which is used to control LCD and "can perform drive

control for a CRT display 49 as an optional display unit" (see Id. col. 3, line 51 through col. 5,

line 53). Display controller 24 includes a monitor detector 57 which (as noted by the Examiner):

> checks on the basis of R, G, and B display signal levels or multi-gradation
> display signal levels output from the DAC 53 whether the external display
> unit (CRT monitor) 49 is connected and whether an optional display unit
> is a color CRT monitor or a monochrome CRT monitor. More specifically,
> the monitor detector 57 compares each display signal level which varies in
> accordance with the loads of the CRT connected to the R, G, and B
> terminals of the DAC 53 with the reference level, and determines on the
> basis of a voltage variations (drops) due to the loads whether the color
> CRT monitor or the monochrome CRT monitor is connected. (See Id., col.
> 7, lines 26-37)

Nowhere does Uehara disclose or suggest that its display controller 24 limits a current to be supplied to the light-emitting unit which illuminates an LCD, or controls a number of the light-emitting units to be turned on, when monitor detector 57 has detected that a CRT is connected to R, G, and B terminals of DAC 53.

Furthermore, in order to implement Uehara's monitor detector 57 in Watts' docking station, Watts' docking station would have to be modified to include Uehara's DAC 53, because according to Uehara determining if a CRT is connected requires checking "on the basis of R, G, and B display signal levels or multi-gradation display signal levels output from the DAC 53" (see Id., col. 7, lines 26-28). Applicant submits that one skilled in the art of data processing devices would not have been motivated to introduce such level of complexity into a docking station.

Even if, assuming *arguendo*, Uehara's monitor detector 57 were to be implemented into Watts' computer docking station in order to "improve utility of Watts because it allowed for a more intelligent means to determine if the laptop display should be disabled," as proposed by the Examiner (see Office Action, page 3), such a combination would not result in Applicant's claimed invention as recited in claims 1, 3 and 13-18. That is, even with the benefit of Uehara's complex CRT detector, Watts' portable computer 13 would perform neither (1) the detecting of whether a specific functional part thereof is in operation or not, nor (2) the controlling of the light-emitting units which illuminate the display thereof. Instead, Watts' docking station would simply disable the monitor of portable computer 13 (which has been loaded into the docking

station after being powered down (see Id., col. 4, lines 16-18)), if it determines (using Uehara's

monitor detector 57) that a CRT is connected to the docking station.

Therefore, Applicant's independent claims 1-4 and 13-18 would not have been obvious

from the unlikely combination of Watts and Uehara.

Furthermore, as explained in Applicant's September 24, 2003 Amendment Montgomery

does not disclose or suggest detecting whether a specific functional part of its handset 104 (such

as its receive/transmit circuits) is in operation or not, as required by Applicant's claimed

invention.

Therefore, Applicant's dependent claims 2 and 4, which incorporate the features of their

respective base claims 1 and 3, would not have been obvious from the combination of Watts,

Uehara and Montgomery, at least for the reasons set forth above.

Rejections based on Ben-Meir and Montgomery (claims 5-12 and 15-18)

Ben-Meir discloses nothing more than a general concept of a power management system

for local area network concentrators or switching hubs where modules communicate power

requirements to a controller which, based on a priority scheme, allocates power to the modules

(see Id., col. 3, line 29 through col. 5, line 14).

The Examiner alleges that it would have been obvious to one of ordinary skill in the art to

achieve Applicant's invention based on Ben-Meir's disclosure. That is, the Examiner's alleged

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prima facie case of obviousness is based on a theory which amounts to the Examiner taking an

official notice of what was well known in the art at the time of Applicant's invention (see Office

Action, page 4, paragraphs 8 and 9).

Applicant respectfully submits that the Examiner's conclusion finds no basis in either the

cited prior art or the general knowledge of artisans skilled in the art of data processing devices.

That is, nowhere does Ben-Meir disclose or suggest that its power management system is

somehow applicable to devices or methods which control illumination of a display unit based on

the operation of a communication unit, as recited in Applicant's claims 5, 7, 9, 11 and 15-18.

Thus, the Examiner is respectfully requested to provide evidence to support his

conclusory statements as to the alleged common knowledge in the art of data processing devices.

In this regard, the Examiner is directed to MPEP 2144.03 which states, *inter alia*, "[i]t is never

appropriate to rely solely on common knowledge in the art without evidentiary support in the

record as the principal evidence upon which a rejection was based" (MPEP 2144.03(E)).

Furthermore, in as much as the Examiner alleges that in Ben-Meir "modules that require

power in a data processing device **could** comprise a display unit and another functional part"

(see Office Action, paragraph 8, emphasis added), the Examiner puts forth either an "inherency"

argument or an argument to demonstrate technical feasibility. Neither argument is correct or

persuasive. MPEP §2112 clearly sates that "the fact that a certain result or characteristic may

occur or be present in the prior art is not sufficient to establish the inherency of that result or

characteristic," *citing In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993)). The MPEP also states

at §2143 that the "fact that references <u>can</u> be . . . modified is not sufficient to establish *prima*

facie obviousness" (emphasis added). Similarly, the same MPEP section emphasizes that the

"fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not

sufficient by itself to establish *prima facie* obviousness." *Id.*

Therefore, even if the assertion that Ben-Meir's modules that require power **could**

comprise a display unit and another functional part, it would not prove the claimed invention to

be obvious.

Thus, the Examiner has failed to formulate a *prima facie* case of obviousness in that the

Examiner failed to presented any factual basis to support the alleged "common knowledge",

which is the primary basis of the Examiner's rejection. Accordingly, the Examiner's rejection of

independent claims 5, 7, 9, 11 and 15-18 based on Ben-Meir should be withdrawn.

With regard to the dependent claims 6, 8, 10 and 12, as noted above, Montgomery does

<u>not</u> disclose or suggest detecting whether a specific functional part of its handset 104 (such as its

receive/transmit circuits) is in operation or not, as required by Applicant's claimed invention.

Therefore, Applicant's dependent claims 6, 8, 10 and 12, which incorporate the features of their

respective base claims 5, 7, 9 and 11, would not have been obvious from the combination of

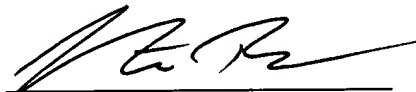Ben-Meir and Montgomery, at least for the reasons set forth above .

Conclusion

In summary, Applicant's independent claims 1, 3, 5, 7, 9, 11 and 13-18, as well as the

dependent claims 2, 4, 6, 8, 10 and 12 (which incorporate all the novel and unobvious

features of their respective base claims), would not have been obvious from any reasonable

combination of the cited references at least for these reasons.

Accordingly, reconsideration and allowance of this application are now believed to be in

order, and such actions are hereby solicited. If any points remain in issue which the Examiner

feels may be best resolved through a personal or telephone interview, the Examiner is kindly

requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue

Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any

overpayments to said Deposit Account.

Respectfully submitted,

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